

REMARKS

Claims 1-4, 6-11, 13-19, 21-24 and 26-33 are pending. No claims have been amended or cancelled. In view of the following remarks, reconsideration and allowance of all the pending claims is requested.

Double Patenting Rejections

Applicants acknowledge the rejection of claims 1-4, 6-11, 13-19, 21-24, and 26-33 under the judicially created doctrine of obviousness-type double patenting. Applicants will consider filing a terminal disclaimer statement once otherwise patentable subject matter has been identified.

Rejections under 35 U.S.C. §103

The Examiner has rejected claims 1-4, 6-11, 13-19, 21-24 and 26-33 under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,073,109 to Flores et al. ("Flores") in view of U.S. Patent No. 5,745,360 to Leone ("Leone"). Applicants traverse this rejection on the following grounds:

- A. Flores and Leone, either alone or in combination with one another, fail to teach or suggest all the elements of the claimed invention;
- B. There is no legally proper suggestion or motivation to combine Flores and Leone; and
- C. The Examiner's alleged motivation constitutes impermissible hindsight.

Before addressing the statutory rejections, Applicants wish to address the Examiner's remarks provided on page 7 of the final office action mailed April 15, 2004. Specifically, the Examiner alleges that Applicants argued against the references individually and asserts that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." Applicants submit that the response in question ("Response", dated December 15, 2003), explains

the deficiencies of both references and further explains why the combination of the references does not render the pending claims unpatentable.

Specifically, the Examiner, in the office action dated March 7, 2003, rejected various ones of the claims as being unpatentable over Flores in view of Leone. The Examiner further proposed incorporating features of Leone into Flores, apparently in an attempt to derive the current invention. In response to this, Applicants describe the deficiencies of Leone as well as the deficiencies of Flores, and further explains why Leone does not provide a teaching or suggestion to make up for the deficiencies of Flores (see Response, page 9, first full paragraph). Applicants have fully addressed the combination of both cited references. Thus, Examiner's allegations with regard to "attacking references individually" is incorrect.

A. Failure to teach or suggest all the claim elements

Independent claim 1 recites, among other things, "a markup language translator that translates the one or more non-markup language objects to representations of one or more markup language objects in order to enable said at least one user to execute said at least one action notified by the workflow means." The Examiner concedes Flores does not teach this feature and relies on Leone to overcome this deficiency. However, neither Flores nor Leone, alone or in combination, disclose at least this feature.

Flores appears to disclose a workflow enabled system for facilitating business processes. At best, Flores describes notifying a user of steps to be completed and managing reminders to the user to keep the process of completing the task moving. However, Flores does not teach or suggest translating a non-markup language object in a workflow system to its representation of a markup language object so that a user of a browser can execute a workflow action required for the translated non-markup language object using the browser. Leone does not remedy this deficiency.

Leone appears to describe a hypertext converter system that converts a non-HTML document to an HTML document. A document that is not formatted as HTML may be converted to an HTML document so that the document may be accessed over communications networks. Leone does not teach nor even suggest enabling a user to

execute a workflow action required for a translated non-markup language object using the browser in response to translating the non-markup language object to a markup language object, and as such does not make up for the deficiencies of Flores. For at least the foregoing reasons, Applicants respectfully submit that claim 1 is patentable over Flores and Leone, both alone and in combination with one another.

Claims 8, 15, and 21 include similar features to those discussed above in relation to claim 1 and are likewise patentable over Flores and Leone. Dependent claims 2-4, 6, 7, 9-11, 13, 14, 16-19, 23, 24, and 26-33 depend from and add additional features to one of independent claims 1, 8, 15, and 21. Thus, for at least the reasons set forth above, the dependent claims are patentable over Flores and Leone.

B. No Legally Proper Suggestion or Motivation to Combine Flores and Leone

One of the criteria necessary to establish a *prima facie* case of obviousness is that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Moreover, the teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).

In the Office Action, the Examiner concedes that Flores fails to disclose a markup language translating means for translating the one or more non-markup language objects to representations of one or more markup language objects in order to enable said at least one user to execute said at least one action notified by the workflow means. See Final Office Action page 5, 1st full paragraph. The Examiner relies on Leone for disclosing this feature:

"It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the system, method and electronic storage medium for translating a non-markup language object as taught by Leone, into the workflow system of Flores, ***for the purpose of enhancing interoperability of legacy systems by enabling operation over the internet.***" See Final Office Action, page 5, 2d full paragraph. (*Emphasis added*).

Applicants submit that the Examiner's alleged motivation to combine Flores and Leone lacks support from either of the references. In fact, neither of the two references relied upon by the Examiner even mentions any legacy system. Flores is concerned with a conventional workflow process; whereas Leone is concerned with translating electronic text documents, specifically book documents, to HTML.

Additionally, the Examiner has not provided any reason why one of ordinary skill would even be motivated to modify Flores's workflow process to translate the workflow objects to a markup language. Thus, Applicants submit that neither Flores, nor Leone, set forth any teaching, suggestion, or motivation to combine the two references, and the Examiner has not set forth a *prima facie* case of obviousness.

C. Impermissible Hindsight

Applicants further submit that the combination of Flores and Leone constitutes impermissible hindsight. In combining Flores with Leone, the Examiner alleges that

"It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the system, method and electronic storage medium for translating a non-markup language object as taught by Leone, into the workflow system of Flores, ***for the purpose of enhancing interoperability*** of legacy systems by enabling operation over the internet." See Final Office Action, page 5, 2d full paragraph. (***Emphasis added***).

Applicants submit that the Examiner's alleged motivation for combining Flores and Leone essentially restates at least one of the advantages of the invention as set forth by the Applicants in the Specification:

"By expressing Notes capabilities to the Web (using a browser) via the present invention, Web developers can take ***advantage of an architecture that integrates database, security, directory, messaging, workflow...in a single platform*** heretofore lacking in browser based systems using HTML objects." See Specification, page 7, lines 2-6. (***Emphasis added***).

Applicants submit that the Examiner's alleged motivation is unsupported by the prior art. As such, the combination is improper. As stated in *In re Vaeck*, "the teaching or suggestion to make the claimed combination...must...be found in the prior art, not in Applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).

Even if Flores and Leone may be properly combined, there is nothing in the combination of references that suggests using the specific combination of elements claimed. To selectively pick and choose among the many disclosed elements constitutes impermissible hindsight. Applicants have shown that, but for their disclosure, one of ordinary skill in the art would not have been motivated to combine Flores and Leone. Thus, Applicants submit that the Examiner has failed to set forth a *prima facie* case of obviousness.

For at least the foregoing reasons, Applicants submit that the Examiner has failed to set forth a *prima facie* case of obviousness for Claims 1-4, 6-11, 13-19, 21-24 and 26-33 based on Flores and Leone.

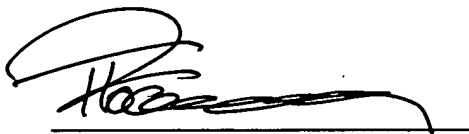
CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Dated: August 16, 2004

Customer Number
29315



Rick A. Toering
Registration No.: 43,195
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND
POPEO P.C.
12010 Sunset Hills Road, Suite 900
Reston, Virginia 20190
703-464-4806